

REMARKS

Claims 1 to 14 were pending in the application at the time of examination. Claims 1 to 14 stand rejected as obvious.

Applicant calls to the Examiner's attention that responsibility for the above application has been transferred by the Assignee to the undersigned attorney. Please direct all future correspondence in the above application to the undersigned attorney. A revocation of attorney and appointment of new attorney will be filed under separate cover.

Claim 1 is amended to remove any discussion about whether the preamble should be considered when the claim is considered as whole and to more clearly link the operations within the Claim. The first limitation was inherent based upon the description and the preamble and so should have been considered in the obviousness rejection, and the second limitation corrects an informality. Thus, the changes do not affect the patentability of the claim.

Claim 3 is amended to correct an informality. There was not a definition of the acronym used in the Claim upon which Claim 3 depended.

Claim 6 is amended to remove any possible ambiguity. This amendment addresses an informality and so does not affect the patentability of the claim.

Claim 7 is amended to remove any discussion about whether the preamble should be considered when the claim is considered as whole. The first limitation was inherent based upon the description and the preamble. Thus, the change does not affect the patentability of the claim.

Claim 8 is amended to remove any discussion about whether the preamble should be considered when the claim is considered as whole and to more clearly link the operations within the Claim. The first limitation was inherent based upon the description and the preamble and so should have been considered

in the obviousness rejection, and the second limitation corrects an informality. Thus, the changes do not affect the patentability of the claim.

Claim 10 is amended to correct an informality. There was not a definition of the acronym used in the Claim upon which Claim 10 depended.

Claim 13 is amended to remove any possible ambiguity. This amendment addresses an informality and so does not affect the patentability of the claim.

Claim 14 is amended to remove any discussion about whether the preamble should be considered when the claim is considered as whole and to more clearly link the operations within the Claim. The first limitation was inherent based upon the description and the preamble and so should have been considered in the obviousness rejection, and the second limitation corrects an informality. Thus, the changes do not affect the patentability of the claim.

Claims 1, 6 to 8, 13, and 14 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,112,049, hereinafter referred to as "Sonnenfeld," taken with U.S. Patent No. 6,418,466, hereinafter referred to as "Lecture." The Examiner stated in part:

prompting a user to indicate a number of each of the sections, said number representing how many questions from each of the sections should be chosen; randomly selecting a number of nodes from each of the sections (Sonnenfeld on col. 21, lines 32 -65; col. 28, lines 12-19; lines 32-36, line 58-col. 29, line 34: teaches the user can indicate a number of sections to give for the text [Sic] and if the sections should be given out randomly; furthermore the user can indicate a number of questions should be given out per section and can determine if the questions should be asked randomly).

Applicant respectfully traverses the obviousness rejection of Claim 1. Applicant first notes that the MPEP requires:

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;

MPEP § 2141, 8th Edition, Rev. 2 p. 2100-120 (May 2004).

Claim 1 does not recite determining "if the questions should be asked randomly" but rather randomly selecting a number of questions for each section based on a user input and then doing further processing before arriving at the questions and answers. The time sequence of the Claim 1 must be considered in considering the claim as a whole.

Simply asking questions randomly teaches away from selecting question randomly and then doing further processing to create a document. In fact, since the questions are presented randomly to the user, the question and answer sequence selected for a particular section are not known until after they are presented to the user.

This is the difference between an interactive system of Sonnenfeld and a method that generates "a question and an answer document," as recited in Claim 1. The system of Sonnenfeld is a computerized testing system, i.e., a "'Interactive Testing and Questionnaire System' (ITS), which allows for the interactive and secure development and production of tests over the Internet" Sonnenfeld, Col. 12, lines 57 to 60.

The Examiner has cited no teaching of a question document that includes a set of questions randomly selected from a database, but rather a set of questions that are randomly asked in the production of the test. Also, the Examiner has failed to cite any teaching of an answer document. Again, since, according to the Examiner, the questions are randomly asked, the question document could not be generated until after the test taker is presented with the randomly asked questions, because the sequence of questions and possibly the question

themselves used would not be known until after the test is administered.

Moreover, Sonnenfeld describes a complex system for designing the interactive test that starts at Col. 16 line 36 and goes to the end of Col. 70. This complex computerized system requires a number of different screens, links, pull down menus etc that "allows for the interactive and secure development and production of tests over the Internet." Id.

Sonnenfeld teaches how to add questions to the test at Col. 42; how to add a section from another test at Col. 36, etc. However, the Examiner has failed to cite any teaching in Sonnenfeld concerning data formats etc. Sonnenfeld is not concerned with data formats, but how to provide an interface for interactive test generation where the test designer specifies every aspect of the test as taught in Col. 16 through Col. 70.

Specifically, Sonnenfeld describes an interface for a test designer to design an interactive test. The Examiner has failed to cite any teaching or suggestion in Sonnenfeld on how the data in the various sections of the test or the various interfaces are managed, e.g., has failed to show that the system of Sonnenfeld utilizes "data from a dynamic schema, having dynamically variable record formats." Lektion Col. 2, lines 60-61. In addition, the Examiner has failed to explain how handling data with dynamically variable record formats has anything to do with question selection for a question and answer document.

Nevertheless, the Examiner cites to a secondary reference Lektion for processing code using data with dynamically variable record formats. The Examiner stated that the motivation for one of skill in the art combining the documents was:

in order to easily and efficiently accommodate format changes of the data without having to modify the code each time the data changes

Even if this were true, handling varying data formats so that the data can be processed without requiring modification to code as in Lektion is unrelated to a method as in either the primary reference or in Claim 1. The processes are at two different levels. Moreover, processing of the data in a particular way so that the code of Sonnenfeld is not modified implies that the teachings as to the interfaces etc. of Sonnenfeld remains unchanged. Applicant's invention as recited in Claim 1 requires as noted by the Examiner modification of Sonnenfeld. Thus, adding a way to manipulate data formats so that the code of Sonnenfeld remains unchanged teaches away from any modification of Sonnenfeld. Accordingly, the very rejection shows that the combination of references leads to an inconsistent result and so fails to suggest Applicant's invention as recited in Claim 1. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claim 6 depends from Claim 1 and so distinguishes over the combination of references for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 6.

Claims, 7, 8, and 14 stand rejected for the same reasons as Claim 1. Again, the combination of documents is unsupported by any teaching in either document, and further, if combined using the motivation relied upon by the Examiner, leads to an inconsistent interpretation. Consequently, the above comments with respect to Claim 1 are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 7, 8, and 14.

Claim 13 depends from Claim 8 and so distinguishes over the combination of references for at least the same reasons as

Claim 8. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 13.

Claims 2 to 5 and 9 to 12 stand rejected as being unpatentable over Sonnenfeld and Lektion and further in view of U.S. Patent No. 6,519,617, hereinafter Wanderski. In the rejection of Claims 2 and 9, the Examiner stated in part:

Wanderski does disclose "porting a document in XML format using DTD" on col. 2, lines 2-8 teaches when the user wishes to display a document formatted into XML the parser uses the DTD to determine how to process the XML document. The DTD is also applied with HTML and SGML (see col. 1, lines 26-col. 2, line 3.)

Applicant respectfully traverses the obviousness rejection. The Examiner has rejected the gist of the Claim 2 and not the explicit claim language. The Examiner cited "porting a document **in XML format**," (Emphasis added) but Claim 2 recites "porting a word processing document into extensible markup language format." Porting a document in XML format teaches or suggests nothing concerning porting a word processing document into XML format. Based upon the Examiner's interpretation, Wanderski fails to teach or suggest the invention of Claim 2. Moreover, the motivation "to process contents within an XML document" (Emphasis added) is further evidence that explicit claim limitations have not been considered. Moreover, the combination is not well founded and even if the combination were correct, the additional information in Wanderski fails to correct the shortcomings of the primary references. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 and 9.

With respect to the obviousness rejection of Claims 4 and 11, and Claims 5 and 12, Applicant respectfully submits that the combination is not well founded and even if the combination were correct, the additional information in Wanderski fails to

correct the shortcomings of the primary references as discussed above with respect to the claims from which these claims depend. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 4, 5, 11 and 12.

Claims 1 to 14 remain in the application. Claims 1, 3, 6, 7, 8, 10, 13, and 14 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 29, 2004.

  
Attorney for Applicant(s)

October 29, 2004  
Date of Signature

Respectfully submitted,



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